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Attorney for Applicant

**PATENT**

**Docket No. JP920000353US1**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|             |  |              |
|-------------|--|--------------|
| Applicant:  | Kishiko Itoh et al.                                  | )            |
|             |  | )            |
| Serial No.: | 09/954,937   | )            |
|             |  | ) Group Art  |
| Filed:      | September 18, 2001                                   | ) Unit: 2142 |
|             |  | )            |
| For:        | <b>COMMUNICATIN ADAPTER AND SELECTION<br/>METHOD</b> | )            |
|             |  | )            |
| Examiner:   | Andrew T. Caldwell                                   | )            |

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Examiner:

In response to the Advisory Action mailed on January 8, 2008, the Applicants respectfully request a Pre-Appeal Brief Conference. The following is a summary of the arguments of the Examiner and the Applicants on the disputed claims:

**Claims 1, 3-7, 9-11, 13-19, and 21-22**

Claims 1, 3-7, 9-11, 13-19, and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 6,493,751 to Tate et al. (hereinafter Tate) in view of United States Patent Number 6,961,762 to Yeap et al. (hereinafter Yeap) and United States Patent Number 6,961,762 to Oh-Yang et al. (hereinafter (Oh-Yang). Final Office Action of August 31, 2007 (hereinafter FOA), page 2.

The Applicants responded that claims 1, 3, 4, 6, 7, 10, 11, 14, 15, 17, 19, 21, and 22 include the limitation “**...disabling all of the plurality of communication adapters; and enabling said communication adapter specified by the user** if it is determined that said communication adapter specified by the user is available, wherein **other communication adapters remain disabled to reduce power consumption...**” Claim 1. See also claims 3, 4, 6, 7, 10, 11, 14, 15, 17, 19, 21, and 22. Applicants further disagreed with the Examiner assertion that Yeap’s disclosure of causing a system to sleep for three seconds before checking link quality teaches other communication adapters remaining disabled. FOA, page 4, lines 5-8. In Yeap, all communication adapters are re-enabled. Yeap, col. 7, lines 41-43. No communication adapter remains disabled as claimed by the present invention, but all are again enabled in order to try to establish another connection. Tate also does not disclose disabling all of the plurality of communication adapters and the communication adapters remaining disabled. FOA, page 4, lines 3-4.

The Examiner further cites Oh-Yang’s disclosure of “...using the Drag & Sleep control circuit 20 to enable the high speed Ethernet controller to get into sleep state or resume normal

state in accordance with the connector unit's connecting status, and to temporarily turn off, in the sleep state, the operation of unnecessary devices in the high speed Ethernet PC card 10, thereby, to attain the objective of energy saving..." as teaching other communication adapters remaining disabled to reduce power consumption as claimed by the present invention. FOA, page 4, lines 12-17 citing Oh-Yang, col. 5, lines 57-65. Applicants respectfully disagree. The drag and sleep control circuit detects that a PC card is disconnected from a network. Oh-Yang, col. 1, lines 59-64. Oh-Yang teaches that Ethernet PC cards (communication adapters) are only disabled when disconnected from a network, rather than other unselected communication adapters remaining disabled as claimed by the present invention.

Applicants submit that the teaching of **disabling all communication adapters, enabling the communication adapter specified by a user** wherein **other communication adapters remain disabled** to reduce power consumption is not disclosed by the combination of Tate, Yeap, and Oh-Yang. Because Tate, Yeap, and Oh-Yang do not teach other communication adapters remaining disabled, Applicants submit that claims 1, 3, 4, 6, 7, 10, 11, 14, 15, 17, 19, 21, and 22 are allowable. Applicants further submit that claims 5, 9, 13, 16, and 18 are allowable as depending from allowable claims.

In the Advisory Action of January 8, 2008, the Examiner asserts that Applicants have ignored the Examiners argument that "Adapters that are disabled, even if only temporarily, inherently results in reduced power consumption." Advisory Action of January 8, 2008, page 4, line 8. This is true. However, Applicants' arguments are that the present invention is distinguished by claiming disabling all communication adapters, enabling the communication

adapter specified by a user wherein other communication adapters remain disabled as discussed above. The distinctions of the present invention regarding reduced power consumption would likely require additional claim limitations.

Respectfully submitted,

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